

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q91609

Toru NISHIBAYASHI, et al.

Appln. No.: 10/557,747

Group Art Unit: 1612

Confirmation No.: 2298

Examiner: Marcos L. SZNAIDMAN

Filed: November 21, 2005

For: DISINFECTANT AND/OR BACTERICIDAL AQUEOUS COMPOSITIONS

PETITION FROM RESTRICTION REQUIREMENT

UNDER 37 C.F.R. § 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Action dated March 7, 2008, the Examiner issued a restriction requirement, requiring Applicants to select one of the following groups for prosecution on the merits:

- Group I - Claims 1, 2 and 4, drawn to a composition containing olanexidine and polyoxyethylene higher alkyl ethers;
- Group II - Claims 1, 3 and 4, drawn to a composition containing olanexidine and polyoxyethylene alkylphenyl ethers;
- Group III - Claims 5-7, drawn to a composition containing olanexidine, polyoxyethylene higher alkyl ethers and an alcohol;
- Group IV - Claims 5-7, drawn to a composition containing olanexidine, polyoxyethylene alkylphenyl ethers and an alcohol;
- Group V - Claims 8, drawn to a composition containing olanexidine, polyoxyethylene higher alkyl ethers and triglycerides;
- Group VI - Claim 8, drawn to a composition containing olanexidine, polyoxyethylene phenylalkyl ethers and triglycerides;

- Group VII - Claims 9-10, drawn to a composition containing olanexidine and an alcohol;
- Group VIII - Claims 11-16 and 18-19, drawn to a composition containing olanexidine and an ester-based non-ionic surfactant;
- Group IX - Claims 11, 17 and 20-21, drawn to a composition containing olanexidine and a cyclic oligosaccharide;
- Group X - Claims 22-23, drawn to a composition containing olanexidine, an ester-based non-ionic surfactant and an alcohol;
- Group XI - Claims 22-23, drawn to a composition containing olanexidine, a cyclic oligosaccharide and an alcohol; and
- Group XII - Claims 24-25, drawn to a method using a composition containing olanexidine.

On March 31, 2008, Applicants elected Group I, claims 1, 2 and 4 with traverse.

Applicants traversed the Examiner's restriction requirement on the basis that the cited reference, Umehara et al, does not teach or suggest a preparation containing olanexidine and an excipient, such as polyoxyethylene higher alkyl ethers, polyoxyethylene alkylphenyl ethers, alcohols, ester-based nonionic surfactants or cyclic oligosaccharides, and, therefore the claims are patentable over Umehara et al, and hence the Examiner should withdraw the restriction requirement.

In the next Action dated July 22, 2008, the Examiner indicated that Applicants' reason for traversing the restriction requirement was not persuasive allegedly because, according to the Examiner, the composition containing olanexidine is obvious from the prior art and therefore it can not be a special technical feature under PCT Rule 13.2. Thus, the Examiner concluded that there is no special technical feature and the inventions of Groups I-XII can be restricted because

they do not relate to a single general inventive concept. The Examiner further stated that the basis for restriction is completely unrelated to whether the claims are patentable or not.

Thus, the restriction requirement was deemed proper and made final.

Subsequently, in the Amendment filed May 29, 2009, Applicants amended claim 1 by incorporating the subject matter of claims 2 and claim 3 and requested reconsideration of the restriction requirement on the basis that the amended claims meet the requirement of unity of invention and should be examined as an invention sharing a single inventive concept. Applicants further argued that “the combination of olanexidine and polyoxyethylene higher alkyl ethers” is a special technical feature under PCT Rule 13.2. Further, Applicants indicated that the cited reference, Umehara et al, does not teach or suggest this special technical feature of the amended claims. Thus, Applicants submitted that amended claim 1 should be examined as an invention sharing a single general inventive concept.

In the Advisory Action mailed June 17, 2009, the Examiner indicated that the amendment to incorporate the subject matter of claim 3 into claim 1 was improper since claim 3 was considered as having been drawn to a non-elected invention, thus effectively denying Applicants’ request for reconsideration of the restriction requirement as to Groups I and II.

Accordingly, Applicants respectfully request review and reconsideration of the Restriction Requirement imposed in the Action dated March 7, 2008 with respect to Groups I and II.

Applicants respectfully submit that the Restriction Requirement imposed in the Action dated March 7, 2008 was timely traversed in the Response filed March 31, 2008 and reconsideration was timely requested in the Amendment filed May 29, 2009.

In view of the position taken by the Examiner in the Advisory Action mailed June 17, 2009, in the Amendment under 37 C.F.R. § 1.114(c) submitted concurrently herewith, claim 1 is amended by deleting the subject matter of original claim 3 and new claim 28 is presented which is directed to the subject matter of original claim 3.

Applicants submit that original claim 1 was generic to original claims 2 and 3 and the subject matter of original claims 1, 2 and 3 meets the requirement of unity of invention and should be examined as an invention sharing a single inventive concept. More specifically Applicants submit that "the combination of olanexidine and polyoxyethylene higher alkyl ethers" is a special technical feature under PCT Rule 13.2. Further, the cited reference, Umehara et al, does not teach or suggest this special technical feature of the amended claims. Thus, Applicants submit that the subject matter of claim 1 as set forth in the Amendment being filed concurrently herewith (which corresponds to the subject matter of original claim 1 and original claim 2) and the subject matter of new claim 28 (which corresponds to the subject matter of original claim 3) meets the requirement of unity of invention and should be examined as an invention sharing a single inventive concept.

Accordingly, Applicants respectfully submit that the restriction requirement should be withdrawn.

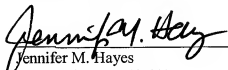
Favorable consideration is requested.

Petition from Restriction Requirement under 37 C.F.R. § 1.144
U.S. Appln. No.: 10/557,747

Atty. Dckt. No.: Q91609

Please charge the petition fee under 37 C.F.R. § 1.144 or 37 C.F.R. § 1.181, if required,
to Deposit Account No. 19-4880.

Respectfully submitted,


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